

Patent
CYM-035
(2174/42)

REMARKS:

In the Office Action, claim 5 and 14 were objected to as dependent on a rejected base claim, and claims 6 and 40 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In addition, claims 1, 2, 7-8, 16 and 41 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,849,497 ("Steinman"). Finally, claims 3, 4, and 9-12 were rejected under 35 U.S.C. § 103(a) as unpatentable over Steinman in view of U.S. Patent No. 5,863,717 ("Lancaster"), and claims 13 and 15 were rejected under 35 U.S.C. § 103(a) as unpatentable over Steinman in view of U.S. Patent No. 6,045,993 ("Mahoney").

In response to the Office Action, claims 1, 6, 13, 40, 41 and 46 have been amended, and claim 5 has been cancelled. Support for the amendment to claim 1 can be found at least in claims 1 and 5 as filed. Support for the amendments to claims 6 and 40 may be found at page 6 line 25 to page 7 line 2. Claims 13 and 46 are amended to correct a typographical error. Claim 41 has been amended to change its dependency from claim 1 to allowable claim 38. No new matter is added.

Applicants appreciate the Examiner's indication that claim 5 would be allowable if rewritten in independent form. Accordingly, claim 1 has been amended to incorporate the subject matter of allowable claim 5, and claim 5 has been cancelled. This amendment overcomes the anticipation and obviousness rejections of claims 1-4, 7-13, 15 and 16 and the objection to claim 14, all of which now depend on an allowable claim.

The amendment of claim 41 to depend on allowed claim 38 obviates the anticipation rejection of that claim.


Patent
CYM-035
(2174/42)

Claims 6 and 40 have been amended to recite that the at least one probe "is a hybrid further comprising a nucleic acid other than PNA." Support for this amendment can be found at least at page 6 line 25 to page 7 line 2, where the specification discusses the use of hybrid probes comprising regions of PNA and regions of other nucleic acids. These claims are thus asserted to clearly set forth that the probe is a hybrid comprising PNA and a nucleic acid other than PNA. Withdrawal of the rejection of these claims as indefinite is respectfully requested.

In view of the foregoing, it is submitted that the claims presented in this application define patentable subject matter over the cited prior art. Accordingly, reconsideration and allowance of the application is requested. The Examiner is welcome to contact the undersigned as set forth below.

Respectfully submitted,
BINGHAM McCUTCHEN LLP

Dated: July 22, 2003

By: 
David W. Maher
Reg. No. 40,077

Three Embarcadero Center, Suite 1800
San Francisco, California 94111
Telephone: (650) 849-4908
Facsimile: (650) 849-4800